Paper No. 44

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte YUJI HATADA,
KATSUYA OZAKI,
KATSUTOSHI ARA,
SHUJI KAWAI, and
SUSUMU ITO

Appeal No. 2003-1815
Application No. 08/952,741

REMAND TO THE EXAMINER

Before WINTERS, WILLIAM F. SMITH, and MILLS, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

ON REMAND TO THE EXAMINER

On consideration of the record, we find that this case is not ready for a disposition on appeal. Accordingly, we remand the application to the examiner for further proceedings not inconsistent with the views expressed herein. The hearing, originally scheduled for January 22, 2004, has been vacated. See Paper No. 43.

First, in the paragraph bridging pages 9 and 10 of their Reply Brief received October 15, 2002 (Paper No. 35), applicants cite pages 8.46-8.63 of the textbook

Molecular Cloning A Laboratory Manual.[1] "Exhibit A" attached to the Reply Brief, however, includes only pages 8.46-8.59 of the text. It is unclear whether applicants (1) inadvertently omitted pages 8.60-8.63 from "Exhibit A," or (2) incorrectly cite pages 8.46-8.63 in the Reply Brief. On return of this application to the Examining Corps, we recommend that applicants clarify just what pages of Molecular Cloning A Laboratory Manual they rely on to support the argument that "[s]creening for clones that contain a cDNA of interest by an enzymological property (i.e. ability to cleave glucosidic linkages) is well known in the art" (Reply Brief, page 9, lines 21-23).

Second, in the PTO communication mailed October 30, 2002 (Paper No. 36), the examiner states that "[t]he reply brief filed October 15, 2002 has been entered and considered." The examiner does not, however, explicitly refer to "Exhibit A" attached to the Reply Brief, and it is unclear whether "Exhibit A" has been admitted in the record. See 37 CFR § 1.195 ("Affidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented"). On return of this application to the Examining Corps, we recommend that the examiner consider the provisions of 37 CFR § 1.195 and state whether "Exhibit A" has been, or has not been, admitted in the record. In this regard, it would not appear that applicants have presented "a showing of good and

[1] Sansbrook et al. (Sansbrook), Molecular Cloning A Laboratory Manual, pp. 8.46-8.63 (2d ed. Cold Spring Harbor Laboratory Press 1989)

sufficient reasons" why the exhibit was not earlier presented. If "Exhibit A" is of record, we recommend that the examiner furnish applicants with a substantive response explaining why their reliance on "Exhibit A" does not overcome the rejection of the appealed claims under 35 U.S.C. § 112, first paragraph (enablement).

Third, it would appear that applicants intend to rely on the Nakajima reference[2] but have not properly presented this reference before the Board. In this regard, we note that Nakajima appears as "Attachment I" to the previous Appeal Brief received October 31, 2001 (Paper No. 25). That Appeal Brief, however, is "defective for failure to comply with one or more provisions of 37 CFR § 1.192(c)." See the PTO communication mailed January 11, 2002 (Paper No. 26). In the instant Appeal Brief received May 13, 2002 (Paper No. 32), page 13, footnote 1, applicants state that the Nakajima reference is Attachment I, but that is incorrect. The only attachment to the instant Appeal Brief is an Appendix reproducing the appealed claims. Further, in the Reply Brief received October 15, 2002 (Paper No. 35), page 2, footnote 1, applicants state that they "submit the following reference [Nakajima]." Applicants have not, however, submitted Nakajima as an attachment to the Appeal Brief or Reply Brief presently before the Board. It is apparent, we believe, that (1) each document relied on by applicants should be self-contained, and (2) the Board should not be led on a paper

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[2] Nakajima et al. (Nakajima), "Comparison of amino acid sequences of eleven different α-amylases," App. Microbiol. Biotechnol., Vol. 23, pp. 355-360 (1986)

chase to match arguments in a properly filed Appeal Brief or Reply Brief with supporting evidence attached to a defective Brief. On return of this application to the Examining Corps, we recommend that applicants clarify whether they intend to rely on the Nakajima reference and, if so, properly present this reference before the Board.

Fourth, as stated in 37 CFR § 1.192(c)(7)(2001):

> Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Here, applicants have not set forth a grouping of claims for each ground of rejection as required by the Rules of Practice. See the Appeal Brief received May 13, 2002 (Paper No. 32), page 8, "Grouping of Claims." In this case, there are two extant grounds of rejection, i.e., claims 3, 4, 15, 16, and 20 through 24 stand rejected as based on a specification which does not comply with the written description and enablement requirements of 35 U.S.C. § 112, first paragraph. On return of this application to the Examining Corps, if the examiner adheres to those grounds of rejection, we recommend that applicants set forth a grouping of claims for each such rejection.

Fifth, in University of Cal. v. Eli Lilly & Co., 119 F.3d 1559, 43 USPQ2d 1398 (Fed. Cir. 1997), and in Enzo Biochem, Inc. v. Gen-Probe, Inc., 296 F.3d 1316, 63

USPQ2d 1609 (Fed. Cir. 2002), the Federal Circuit addressed application of the written description requirement to DNA-related inventions. Based on our review of the Examiner's Answer (Paper No. 33, mailed August 13, 2002, section (10) "Grounds of Rejection"), it would not appear that the examiner (1) adequately considered the relevant principles of law set forth in those cases, or (2) enunciated a rejection of claims 3, 4, 15, 16, and 20 through 24 under 35 U.S.C. § 112, first paragraph (written description requirement) in light of relevant legal precedent. On return of this application to the Examining Corps, we recommend that the examiner take a step back and review the written description rejection in light of relevant legal precedent (University of Cal. v. Eli Lilly & Co., supra; Enzo Biochem, Inc. v. Gen-Probe, Inc., supra) and applicable PTO guidelines. It would appear that the rejection of applicants' claims under 35 U.S.C. § 112, first paragraph (written description requirement), if adhered to by the examiner, must be reformulated in light of relevant legal precedent and applicable PTO guidelines. Under these circumstances, we are not authorizing a Supplemental Examiner's Answer under the provisions of 37 CFR § 1.193(b)(1).

Conclusion

In conclusion, for the reasons set forth, we find that this case is not ready for a disposition on appeal. Accordingly, we remand the application to the examiner for

further proceedings not inconsistent with the views expressed herein. The hearing, originally scheduled for January 22, 2004, has been vacated.

REMANDED

Sherman D. Winters
Administrative Patent Judge

William F. Smith
Administrative Patent Judge

Demetra J. Mills
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS AND
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